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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,231	03/17/2004	Shigeaki Yamanaka	04132/LH	5636
1933	7590	03/28/2006	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708			BONK, TERESA	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/803,231	Applicant(s) YAMANAKA ET AL.	
	Examiner Teresa M. Bonk	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) 6-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/17/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1-6-05; 3-17-04</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Claims 6-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 1, 2006.

With regards to applicant's request for examination of claims 14, 16, and 17, it noted that through the election of Group 1 it is understood that claims 6-19 are withdrawn. Even though claims 14, 16, and 17 depend from the claims in Group 1 they were not elected; and therefore will not be examined.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller et al. (US Patent 5,218,853). Mueller et al. discloses a method of forming a hollow stepped shaft (54) comprising the steps of holding an upper and lower part axially of a solid rod-like blank (48) with an upper (14) and a lower die (16), respectively, which have a stepped recess of large diameter in a region thereof where they are opposed to each other (cavities 18 and 20); compressing the blank from both its axially opposite sides with an upper (26) and a lower punch

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(28) each of which is smaller in diameter than the blank (Figure 1) at least one of which is moving, thereby extruding the blank so that an axial hollow is formed therein about its axis in each of the upper and lower parts and that a portion of the blank opposed to the stepped recess of the large diameter expands in diameter (Column 4, lines 26-36) and deforms into the recess while leaving a solid plug-like portion (slug 52). Further compressively moving the punches to shear the solid plug-like portion and force it out of the blank (Column 4, lines 67-68 and Column 5, lines 1-7). The blank is loaded into the dies, which are in a closed die-fastened state, and thereafter extrusion of the blank is performed with the punches (Figure 2). The blank is loaded into the dies, which are in an open die-unfastened state, and thereafter extrusion of the blank are performed with the punches while the dies are being closed and fastened (Figure 1).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al. in view of Inoue (US Patent 5,0088,311). Mueller et al. discloses the invention as claimed except for the method further comprising a further step wherein the hollow stepped shaft is further formed in another die set to impart an additional outer contour with a mandrel inserted. Inoue discloses a method of making a hollow stepped shaft comprising a further step wherein the hollow stepped shaft is further formed in another die set to impart an additional outer contour with a mandrel (Claim 1 and Figures 14 and 15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to further form Mueller et al. invention's with a mandrel in order to achieve a desired product.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and further show the state of the art.

US Patents 4,299,112; 4,932,251; and 4,653,310

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa M. Bonk whose telephone number is (571) 272-1901. The examiner can normally be reached on M-F 7:30AM - 5PM with alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Teresa M. Bonk
Examiner
Art Unit 3725

A handwritten signature in black ink, appearing to read 'Derris H. Banks', with a large, stylized loop at the end.

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700